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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,046	06/29/2007	David W. Old	17795 PCT US (AP)	3455

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ALLERGAN, INC.
2525 DUPONT DRIVE, T2-7H
IRVINE, CA 92612-1599

EXAMINER
SHTERENGARTS, SAMANTHA L

ART UNIT	PAPER NUMBER
4131	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/599,046	OLD ET AL.	
	Examiner	Art Unit	
	SAMANTHA SHTERENGARTS	4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *03 November 2006, 05 December 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. **Claims 1-20** are currently pending in the instant application.

Priority

2. The instant application is a national stage entry of PCT/US06/07797 filed March 6, 2006, which claims priority to U.S. Provisional Application 60/660,748, filed March 10, 2005.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on December 5, 2006 and November 3, 2006 were in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Both IDS documents were considered. A signed copy of each form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 112

(First Paragraph)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

As stated in the MPEP 2164.01(a), "There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue."

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have need described. They are:

1. The nature of the invention
2. The state of the prior art
3. The predictability or lack thereof in the art
4. The amount of direction or guidance present
5. The presence or absence of working examples
6. The breadth of the claims
7. The quantity of experimentation needed, and
8. The level of skill in the art

4. **Claims 1-20** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds of the formula in claim 1 and pharmaceutically acceptable salts thereof, does not reasonably provide enablement for prodrugs thereof. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and, concomitantly, to use the invention commensurate in scope with these claims. Specifically, Claims 1-20 are drawn to various inventions comprising a "prodrug" as instantly claimed.

The Nature of the Invention

Claims 1-20 are drawn to a compound of the formula in claim 1, a pharmaceutically acceptable salt thereof, or a prodrug thereof, a pharmaceutical composition comprising that prodrug, and a method of treating glaucoma or ocular hypertension by administering a prodrug of claim 1. Finding a prodrug is an empirical exercise. Predicting, e.g., if a certain compound is in fact a prodrug that produces the active compound metabolically at a therapeutic concentration and a useful rate, is filled with experimental uncertainty. Attempts have been made to predict

drug metabolism *de novo,* but this is still an experimental science. A prodrug of a compound must meet three tests. It must itself be biologically active. It must be metabolized to a second substance *in vivo* at a rate and to an extent to produce that second substance at a physiologically meaningful concentration. Thirdly, that second substance must be biologically active. Determining whether a particular compound meets these three criteria requires a clinical trial setting and a large quantity of experimentation.

The State of the Prior Art

"Pro-drugs" are commonly known in the art as drugs which are administered in an inactive (or less active) form, and then metabolized in vivo into an active metabolite. As disclosed in Stella (Expert Opinions *Prodrugs as therapeutics*), "prodrugs are bioreversible derivatives of drug molecules used to overcome some barriers to the utility of the parent drug molecule. These barriers include, but are not limited to, solubility, permeability, stability, presystemic metabolism, and targeting limitations" (277). Stella, Valentino J, Expert Opinion of Therapeutic Patents, *Prodrugs as therapeutics*, 2004 14(3): 277-280. Wolff et al. (Burger's Medicinal Chemistry, 5th Ed., Vol. 1, pgs. 975-977, 1994) summarizes that state of the prodrug art, the lengthy research involved in successfully identifying a prodrug, and difficulties of extrapolating between species. With the limited direction and exemplification the specification offers, it is highly unpredictable that the compounds of the formula of claim 1 will actually form effective prodrugs. The evidence supports the conclusion that the method of making claimed prodrugs is a subject for further study and experimentation.

The Level of Skill in the Art and the Predictability or lack thereof in the art

The level of skill of the pharmacological art involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities as prodrugs. There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any prodrug on its face, without evidence to support that particular prodrug. It is noted that the pharmaceutical art is unpredictable and requires the embodiments to be individually assessed for physiological activity. Thus, the more unpredictable the art, the more information in support of the invention is required to satisfy the statute. See *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970). Each embodiment of a prodrug must be supported by this invention in order to be enabled for the full range of prodrugs of compounds of the formula in claim 1.

The Amount of Direction or Guidance Present

The specification discloses in ¶ [0258] "the term "prodrug" is a compound which is converted to a therapeutically active compound after administration, and the term should be interpreted as broadly herein as is generally understood in the art." This disclosure is directed to any pharmaceutically acceptable prodrug; however, as discussed above, it would be necessary for Applicant to provide evidentiary support for each embodiment due to the unpredictability in the art with regards to the success of prodrugs with some drugs over others. Additionally, the examples in the specification are not sufficient to enable one skilled in the art to which it pertains to make and use any pharmaceutically acceptable prodrug as interpreted broadly by one of ordinary skill in the art. There are no working examples drawn to prodrugs of compounds of the formula of claim 1. The specification does not adequately enable a method of making all

prodrugs of the compounds that the claims encompass. The specification has limited exemplification thereof and of the necessary starting materials, as discussed *supra*.

As stated in Morton International Inc. v. Cardinal Chem, Co., 28 USPQ2d 1190:

> [T]he specification purports to each, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However... there is no evidence that such compounds exist... the examples of the patent do not produce the postulated compounds..., there is...no evidence that such compounds even exist.
>
> The same circumstance is true here.

The Breadth of the Claims

The claims are drawn to any compound which is converted to a therapeutically active compound after administration, and the term should be interpreted as broadly in the instant application as is generally understood in the art (as defined in the specification). As discussed above, this broad disclosure cannot possibly enable one skilled in the art to which it pertains to make and use any pharmaceutically acceptable prodrug due to the unpredictability in the art with regards to the success of prodrugs with some drugs over others.

The specification provides limited support, as noted above, for the large number of prodrugs encompassed by the claims. The quantity of experimentation needed to make and use all of the prodrugs encompassed by the claims would be an undue burden on one skilled in the chemical art, since the skilled artisan is given inadequate guidance for the reasons state above. Even with the undue burden of experimentation, there is no guarantee that one would obtain the desired prodrugs in view of the Wolff reference.

This discussion established *prima facie* non-enablement. Cancellation of "prodrug" from the claims (1, 3, 6, 12, and 15) would overcome this rejection.

The Quantity of Experimentation Needed

Based on the unpredictable nature of the invention and the state of the prior art and the breadth of the claims, one of ordinary skill in the pertinent art would be burdened with undue experimentation study to determine whether any pharmaceutically acceptable prodrug of compounds of the formula of claim 1 would successfully act as prodrugs as they are known in the art. Therefore, in view of the Wands factors discussed above, to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to test which prodrugs, if any, would produce desired activity with compounds of the formula of claim 1 with no assurance of success.

5. **Claims 1-20** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds with substituent A wherein no carbon atoms have been replaced with S or O, and with substituent A wherein the second carbon atoms has been replaced with O, does not reasonably provide enablement for all compounds with substituents of A "wherein 1 or 2 carbon atoms may be replaced by S or O" and "wherein 1 CH_2 may be replaced by S or O." The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

The Nature of the Invention

In the instant case, claim 1 contains substituents of A "wherein 1 or 2 carbon atoms may be replaced by S or O" and "wherein 1 CH_2 may be replaced by S or O."

The Amount of Direction and Guidance Present

The instant disclosure shows various embodiments that are *contemplated* as containing A substituents with S or O replacing 1 or 2 or the carbon atoms. Pages 8 and 9 of the instant disclosure contain 55 variations of where the S and O atoms can replace the C atoms. These examples are just exemplifications, but not definitions of where S and O are going to replaced C atoms. In many of these variations, there are double and triple bonds in different positions relative to one another. The addition of an S or O atom changes the activity of a compound. The addition of two S or O atoms changes the activity of certain compounds even more. It is well known in the art that S and O atoms are not obvious variants of C atoms and therefore do not retain the identical activity, reactivity, and most importantly, treatment effects, as those compounds without the S and O atoms. Applicants are enabled for compounds which contain an O in the second carbon position of substituent; however, Applicants have not disclosed any working examples wherein the other conditions occur. No examples have been disclosed which would demonstrate or guide one skilled in the art as to how products of instant claim 1 were prepared or obtained. In re Gardner, 166 USPQ 138 (1970).

The breadth of the claims

Compounds of claim 1 which contain substituent A "wherein 1 or 2 carbon atoms may be replaced by S or O" and "wherein one CH_2 may be replaced by S or O."

Level of Skill in the Art and Amount of Experimentation Required

It would require undue experimentation for one of ordinary skill in the art to determine at which positions S and O can replace C or CH_2 and retain the identical pharmacological activity. Additionally, it would require undue experimentation for one to determine if any of these compounds would even retain the identical pharmacological activity. Although the level of skill in the art is high, in order to practice the instantly claimed invention, one skilled in the art would have to speculate on how the products of instant claim 1 were obtained or prepared. Therefore, the instant invention "wherein 1 or 2 carbon atoms may be replaced by S or O" and "wherein 1 CH_2 may be replaced by S or O" is not enabled.

6. **Claims 1-20** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds of the formula in claim 1 and pharmaceutically acceptable salts, does not reasonably provide enablement for metabolites thereof. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and, concomitantly, to use the invention commensurate in scope with these claims.

The Nature of the Invention

Claims 1-20, are drawn to compounds of the formula in claim 1, pharmaceutically acceptable salts, and metabolites thereof. Finding a metabolite is an empirical exercise. The term *metabolite* is usually restricted to small molecules. A primary metabolite is directly involved in the normal growth, development, and reproduction. A secondary metabolite is not directly involved in those processes, but usually has important ecological function. Examples include antibiotics and pigments. A metabolite must be biologically active. Determining whether a

particular compound meets these criteria requires a clinical trial setting and a large quantity of experimentation. www.en.wikipedia.org/wiki/Metabolomics

The State of the Prior Art

"Metabolites" are commonly known in the art as intermediates and end products of metabolism. The art shows that there are divergent types of metabolites, primary and secondary. One set of metabolites (primary) allow organisms to maintain life by growing, reproducing, and sustaining themselves in their environment. The other set of metabolites (secondary) incorporates the use of antibiotics, which are chemotherapeutic agents that inhibit the growth of micro-organisms, such as bacteria, fungi, or protozoa. www.en.wikipedia.org/wiki/Metabolomics.

Based on the teachings of the art, it is unclear whether Applicant's invention is drawn to primary or secondary metabolites in the first place.

The Level of Skill in the Art and the Predictability or lack thereof in the art

The level of skill of the pharmacological art involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities as metabolites. There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any metabolite on its face, without evidence to support that particular metabolite. It is noted that the pharmaceutical art is unpredictable and requires the embodiments to be individually assessed for physiological activity. Thus, the more unpredictable the art, the more information in support of the invention is required to satisfy the statute. See *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970). Each

embodiment of a metabolite must be supported by this invention in order to be enabled for the full range of metabolites of the instantly claimed compounds.

Kwon et al, teaches the correlation between the rate of metabolite formation and the *in vivo* metabolic clearance of the drug. "Rate data generated from certain *in vitro* systems may underestimate the true metabolic clearance *in vivo* owing to limitations in discerning metabolic capability." (Kwon, Younggil. *Handbook of Essential Pharmacokinetics, Pharmacodynamics and Drug Metabolism for Industrial Scientists* . 24 June 2001. page 213, paragraph 3).

The Amount of Direction or Guidance Present

The specification defines metabolites as ¶ [0259] "A metabolite is broadly defined as a compound which is formed in vivo from the disclosed compound." This disclosure is directed to any compound which is formed *in vivo*; however, as discussed above, it would be necessary for Applicant to provide evidentiary support for each embodiment due to the unpredictability in the art with regards to the success of metabolites with some drugs over others. Additionally, the lack of examples in the specification are not sufficient to enable one skilled in the art to which it pertains to make and use any metabolite as interpreted broadly by one of ordinary skill in the art. There are no working examples drawn to metabolites of compounds of the formula of claim 1. The specification does not adequately enable a method of making all metabolites of the compounds that the claims encompass. The specification has limited exemplification thereof and of the necessary starting materials, as discussed *supra*.

As stated in Morton International Inc. v. Cardinal Chem, Co., 28 USPQ2d 1190:

> [T]he specification purports to each, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However... there is no evidence that such compounds exist... the examples of the patent do not produce the postulated

> compounds..., there is...no evidence that such compounds even exist.
>
> The same circumstance is true here.

The Breadth of the Claims

The claims are drawn to any metabolites of the instantly claimed compounds. As discussed above, the lack of disclosure directed towards metabolites cannot possibly enable one skilled in the art to which it pertains to make and use any metabolite due to the unpredictability in the art with regards to the success of metabolites with some drugs over others.

The specification provides no support, as noted above, for the large number of metabolites encompassed by the claims. The quantity of experimentation needed to make and use all of the metabolites encompassed by the claims would be an undue burden on one skilled in the chemical art, since the skilled artisan is given inadequate guidance for the reasons state above. Even with the undue burden of experimentation, there is no guarantee that one would obtain the desired metabolites in view of the Kwon et al. reference.

This discussion established *prima facie* non-enablement. Cancellation of "metabolite" from the claims would overcome this rejection.

The Quantity of Experimentation Needed

Based on the unpredictable nature of the invention and the state of the prior art and the breadth of the claims, one of ordinary skill in the pertinent art would be burdened with undue experimentation study to determine whether any metabolite of the instantly claimed compounds would successfully act as metabolites as they are known in the art. Therefore, in view of the Wands factors discussed above, to practice the claimed invention herein, a person of skill in the

art would have to engage in undue experimentation to test which metabolites, if any, would produce desired activity with the instantly claimed compounds with no assurance of success.

(Second Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 6-7, 12, and 15 (and subsequent dependent claims 2, 4-5, 8-11, 13-14, and 16-20), specifically, contain forms of the terms "comprise" and "having", used in the definitions of the compounds in the claims that render the products indefinite. Forms of the term "comprise," as found in the claims, are considered open-ended language and therefore is including additional subject matter in the compounds of the claims that is not described in the instant specification and is not particularly pointed out or distinctly claimed. For example, an amide or ester comprising up to 14 carbon atoms can be read to include additional atoms and groups other than carbon and alkyl, however, the identity of the additional atoms or groups is unknown and how to determine the identity of the additional atoms or groups is not pointed out or distinctly claimed. Additionally, forms of the term "having" can be considered open ended language and is therefore including additional subject matter in the compounds of the claims that is not described in the instant specification and is not particularly pointed out or distinctly

claimed. A definition of a chemical compound cannot be open-ended, as "having" a particular structure because it appears that that structure can be isolated, or can be otherwise embedded in a larger structure "having" a smaller structure inside of it. Definitions for chemical compounds must be claimed in precision.

Claim 1 (and subsequent dependent claims 2-20), specifically, contains the phrase "wherein 1 or 2 carbon atoms may be replaced by S or O." This phrase renders the claim indefinite because it is unclear which of the carbon atoms in the alkyl chain will be replaced by S or O. It is unclear as to which compounds with S or O instead of C Applicant is claiming as the invention.

Claims 5, 8, 12, and 15-16 specifically, contain the following words: "interthienylene" (claims 5 and 8), "interheteroaryl" (claims 12 and 15), "interaryl" (claims 12 and 15), and "interthienyl" (claim 16). These words are recognized as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. None of these words are commonly known in the art, nor are they defined in the specification. It is unclear what is meant by these terms with regards to the subject matter Applicant is claiming as the instant invention.

Claim 17 recites the terms, "N-aryl" and "N-heteroaryl" gamma lactam. It is not clear which specific N-aryl or N-heteroaryl forms of the formula of instant claim 1 Applicant is referring to. The specification discloses, ¶ [0088] "Another compound is an N-aryl or N-heteroaryl gamma lactam which is active at a prostaglandin receptor. This compound may or may not incorporate any other structural limitation disclosed herein." This definition for the N-

aryl or N-heteroaryl form of the instantly claimed compounds is unclear. It is suggested to delete the terms "N-aryl" or "N-heteroaryl" from the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claim 20** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 20 is drawn to the use of a compound of claim 1 in the manufacture of a medicament for the treatment of glaucoma or ocular hypertension, but since the claim does not set forth any steps involved in the manufacture, it is unclear what the method/process Applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active steps delimiting how this use is actually practiced.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See, for example, *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. V. Brenner,* 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. **Claims 1-20** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/778,800 and claims 1-20 of copending Application No. 11/747,490. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons below.

Determining the scope and contents of Claims 1-20 of Co-pending application No. 11/747,490 and 11/778,800

Claims 1-20 of co-pending application no. 11/778,800 and claims 1-20 of copending application no. 11/747,490 completely encompass the genus of the instant claims (when J is C=O) with the only difference being the positional isomerism of the genus claimed in the instant application.

Ascertaining the differences between Claims 1-20 of Co-pending application No. 11/747,490, Claims 1-20 of Co-pending application No. 11/778,800 and instant claims 1-20

Claims 1-20 of co-pending application No. 11/747,490 and claims 1-20 of co-pending application No. 11/778,800 and disclose a generic compound with various substituents on the ring, methods of treating glaucoma or ocular hypertension, and a composition comprising a compound of the claim 1 with an ophthalmically acceptable liquid. This generic compound of both co-pending applications are drawn to positional isomers of instant claims 1-17, positional isomers being administered for the method of treating glaucoma or ocular hypertension of instant claim 18, and positional isomers of the composition of instant claim 19.

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness

Positional isomers are generally of sufficiently close structural similarity because there is a presumed expectation that such compounds possess similar properties. MPEP §2144.09, *Ex parte* Henkel 130 USPQ 474, (1-phenyl-3-methyl-4-hydroxypyrazole) obvious over reference teaching (3-phenyl-5-methyl-4-hydroxypyrazole). *Ex parte* Weston, 121 USPQ 429.

One of ordinary skill would be motivated to make the positional modifications required to arrive at the instant invention with reasonable expectation for success of obtaining a compound that is active for the treatment of glaucoma or ocular hypertension. Examiner expects the positional isomers would retain the activity of the instantly claimed compounds. It is obvious to one of ordinary skill to make this modification with reasonable expectation for success. The motivation to make this modification would be to make alternate compounds for the quoted purpose.

Conclusion

10. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samantha Shterengarts whose telephone number is (571)270-5316. The examiner can normally be reached on Monday thru Thursday, 9AM – 6PM Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Cecilia Tsang and Janet Andres can be reached on 571-272-0562 and 571-272-0867, respectively. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAMANTHA SHTERENGARTS/
Examiner, Art Unit 4131

/Kamal A Saeed, Ph.D./
Primary Examiner, Art Unit 1626